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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/995,587	11/29/2001	Sacha Adrianus Fokke Taco Van Hijum	BO43667-CIP	2951

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EXAMINER

PROUTY, REBECCA E

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 06/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/995,587

Applicant(s)
Van Hijum et al.

Examiner
Rebecca Prouty

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1652



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 21, 2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-15, and 17-23 is/are pending in the application.
- 4a) Of the above, claim(s) 1-9 and 11-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15 and 17-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other: _____

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Claims 10 and 16 have been canceled. Claims 1-9, and 11-15 and 17-23 are at issue and are present for examination.

Applicants' arguments filed on 4-21-03, paper No. 13, have been fully considered and are deemed to be persuasive to overcome some of the rejections previously applied. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn.

Claims 1-9 and 11-14 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 10.

This application contains claims 1-9 and 11-14 drawn to an invention nonelected with traverse in Paper No. 10. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim 15 is objected to because of the following informalities: "nucleic acid construct gene" in part (b) is grammatically awkward and redundant. Either "nucleic acid construct" or "gene" is suggested. Appropriate correction is required.

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Claim 18 is objected to because of the following informalities: the word "having" should be inserted in line three before $\beta(2-1)$. Appropriate correction is required.

Claim 18 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The limitations of Claim 18 are now recited in Claim 15 from which it depends such that they are now of identical scope.

Claim 23 is objected to because of the following informalities: the phrase "linked D-" should be inserted following $\beta(2-6)$ in line 3. Appropriate correction is required.

Claims 20-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 20 is incomplete as depending from canceled Claim 16. For examination, it is assumed applicants intend the claim to depend from Claim 15.

Claims 21 and 22 are unclear in the recitation of "food grade vehicle" as it is not defined what this encompasses and this is not standard terminology in the art. Applicants argue

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that the term is understood in the art. However, the examiner disagrees that this is standard terminology. Particularly, the scope of the term vehicle is unclear. Is this limited to particular things or does it include such minor food components such as vitamins or flavorants etc. If as applicants state the examiner's previous interpretation (i.e., one or more additional components suitable for ingestion by an animal) is correct it is suggested that this term be amended to "one or more food-grade components".

Claims 15, and 18-22 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for methods of using fructosyltransferases having at least 85% amino acid sequence identity to SEQ ID NOS:1 or 11, does not reasonably provide enablement for methods of using any fructosyltransferase having at least 75% amino acid sequence identity to SEQ ID NOS:1 or 11. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The rejection is explained in the previous Office Action.

Applicants argue that the rejection under 35 U.S.C. §112, first paragraph is not proper because the specification teaches the complete nucleotide and amino acid sequences of the

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fructosyltransferases of SEQ ID NOS:1 and 11 and methods for producing variants and testing for enzymatic activity of a disclosed sequence are within the skill of the ordinary artisan. This is not persuasive because while methods to produce variants of a known sequence such as site-specific mutagenesis, random mutagenesis, etc. are well known to the skilled artisan producing variants as claimed by applicants (i.e., encoding a fructosyltransferase capable of producing a $\beta(2-1)$ or $\beta(2-6)$ linked fructooligo- or fructopoly-saccharide) requires that one of ordinary skill in the art know or be provided with guidance for the selection of which of the infinite number of variants have the claimed property. Without such guidance one of ordinary skill would be reduced to the necessity of producing and testing all of the virtually infinite possibilities. This would clearly constitute **undue** experimentation. While enablement is not precluded by the necessity for routine screening, if a large amount of screening is required, the specification must provide a reasonable amount of guidance with respect to the direction in which the experimentation should proceed. Such guidance has **not** been provided in the instant specification. As previously stated the specification does not establish: (A) regions of the protein structure which may be modified without effecting

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fructosyltransferase activity; (B) the general tolerance of fructosyltransferases to modification and extent of such tolerance; (C) a rational and predictable scheme for modifying any fructosyltransferase residues with an expectation of obtaining the desired biological function; and (D) the specification provides insufficient guidance as to which of the essentially infinite possible choices is likely to be successful.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 15, 17-20 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by van Geel-Schutten et al. (1999) or van Geel-Schutten et al. (1998). The rejection is explained in the previous Office Action.

Applicants argue that the van Geel-Schutten et al. publications fail to fully characterize and identify the enzymes and therefore are not enabling. This is not persuasive because van Geel-Schutten et al. (1999) and van Geel-Schutten et al. (1998) compositions comprising *Lactobacillus reuteri* strain LB121 and lysates thereof and methods of producing fructans therefrom. Complete characterization of the enzyme within these compositions

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which are used is unnecessary for the skilled artisan to do the methods taught by the references. Furthermore, contrary to applicants statements the references do teach the combination of the enzymes with sucrose as in each case the fructan was produced by growing on sucrose. As such the references are clearly enabling and anticipate the instant claims.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over either of van Geel-Schutten et al. (1999) and van Geel-Schutten et al. (1998). The rejection is explained in the previous Office Action.

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Applicant has not presented any arguments specifically traversing this rejection but instead relies upon the traversal discussed above. Therefore, this rejection is maintained for the reasons presented above.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rebecca Prouty, Ph.D. whose telephone number is (703) 308-4000. The

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examiner can normally be reached on Monday-Friday from 8:30 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy, can be reached at (703) 308-3804. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Rebecca Prouty
Primary Examiner
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